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EXAMINER

AHMED, SAMIR ANWAR

ART UNIT	PAPER NUMBER
2623	14

DATE MAILED: 03/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
391252034	Satoshi Hoshino
Examiner S. Ahmed	Group Art Unit 2623

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- Responsive to communication(s) filed on 12/21/01
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- Claim(s) 8-25 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- Claim(s) 8-25 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All Some* None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) _____.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892 Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

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1. The amendment filed 12/21/01 have been entered and made of record.
2. The drawings (Fig. 7) filed 12/21/01 is not approved because it constitutes new subject matter (see para.7).

Applicant has amended the specification by rewriting the second paragraph beginning on line 15 on page 9, and added “Figure 7 shows the projected portion 6b below the recessed portion 10a under the influence of surplus pressure”. The amendment filed 12/21/01 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure (see para.7).

3. Applicant's arguments filed 12/21/01 have been fully considered but they are not persuasive with regard to claims 8-25 for the following reasons:

35 USC § 112, first paragraph Rejections:

As to claims 8-25, the Applicant alleges that “page 9, lines 22-24, which state that the click impression prevents insufficient and surplus pressure of the fingertip, would convey to one of ordinary skill in the art that the way to avoid a click impression when the pressure is too high is to move the contact surface below the detent position and override the lock mechanism [,]” (page 3, line 17-page 4, line 13). The Examiner disagrees. Firstly, lines 22-24 on page 9 are a conclusion statement “Therefore, the click impression prevents insufficient and surplus pressure of the fingertip” for the paragraph that starts on line 15 and ends on line 24 and should be understood and interpreted in view of that paragraph. That paragraph, clearly states on lines 15-17 that a click impression from the lock mechanism 8 can inform the user whether the pressure of the fingertip is sufficient or not. On lines 17-21, that paragraph makes even more clear that a

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user can adjust the pushing power of the fingertip until the click impression is obtained, the user continues to push the contact surface 6, and may increase the pressure. It is clear from the language of lines 17-21 that the contact surface is above the lock mechanism 8 as shown in Fig. 2 (as ordinarily filled) and the user continues to push the contact surface 6 to increase the pressure until the contact surface 6 reaches the lock mechanism 8 position (detent position) and a click impression from the lock mechanism 8 can inform the user whether the pressure of the fingertip is sufficient or not. No way the language of lines 17-21 is applicable to the contact surface 6 being below the lock mechanism 8 position (detent position), simply because when the user continues to push the contact surface 6 to increase the pressure, the contact surface 6 is moving away from the lock mechanism 8 position (detent position) and no click impression is generated. The language of lines 17-21 does state, suggest or imply that the user releases the contact surface 6 to decrease the pressure, so that the contact surface 6 can move back up to the lock mechanism 8 position (detent position) and a click impression is generated. That paragraph on lines 21-22, states “Thus, click impression notifies the user of unnecessity of pushing the contact surface 6 any more”, i.e. the click impression generated when the contact surface 6 reaches the lock mechanism 8 position, notifies the user who is pushing the contact surface 6 down towards the lock mechanism 8 position (detent position) not to push anymore because the contact surface 6 is locked by the lock mechanism 8 and the click impression from the lock mechanism 8 informs the user not to push anymore. It is clear that the paragraph of lines 15-24 on page 9, is concerned with generating a click impression once the contact surface 6 which is

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moving down reaches the lock mechanism 8 in order to inform the user not to push anymore and therefore, the click impression prevents insufficient (no click impression, continue to push down) and surplus (click impression, stop pushing) pressure of the fingertip. Secondly, it would not be apparent to one of ordinary skill in the art that the way to avoid a click impression when the pressure is too high is to move the contact surface below the detent position and override the lock mechanism because:

(A) The paragraph of lines 15-24 on page 9 as explained above is concerned with generating a click impression and is not concerned with avoiding a click impression when the pressure is too high (as the Applicant argues).

(B) The paragraph of lines 15-24 on page 9 as explained above discloses generating a click impression once the contact surface 6 who is moving down reaches the lock mechanism 8 in order to inform the user not to push anymore and therefore, the click impression prevents insufficient and surplus pressure of the fingertip and does not disclose to move the contact surface below the detent position and override the lock mechanism nor how to perform it. That paragraph does disclose how to override the lock mechanism to move the contact surface below the detent position once it is locked by the lock mechanism.

© The specification as originally filed clearly states on page 6, lines 15-17, that the contact surface 6 is pushed down to the lock mechanism 8 placed at a predetermined position, it is locked by the lock mechanism 8 (i.e. the lock mechanism 8 prevents the contact surface 6 from moving below the lock mechanism 8 placed at a predetermined position). Nowhere in the

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specification as originally filed there is a recitation of the contact surface 6 moving below the lock mechanism 8 placed at a predetermined position if too much pressure is applied to the contact surface 6 nor overriding the lock mechanism to move the contact surface below the detent position once it is locked by the lock mechanism nor how to perform it.

35 USC § 103 Rejections:

As to claim 20, the Applicant alleges that “the switch in FILIP is for snowmobiles [,]” (page 7, lines 11-15). The Examiner disagrees. FILIP clearly states that the switch is not exclusively for application on vehicles (col. 1, lines 18-19). The Applicant alleges that “ FILIP states that the switch will remain locked in a position when pressed [,]” (page 7, lines 18-22). The Examiner disagrees. Filip discloses that if the button 30 is depressed (i.e. the button is pressed the first time and is locked) then pressing the actuating end of the button with the finger which releases the button from the lock position (col. 3, lines 47-52). The Applicant alleges that “ There is no art of record that indicates why these references should be combined [,]” (page 8, lines 3-8). The Examiner disagrees. Yasaku discloses the use of a switch that triggers the detection of a fingerprint, the switch does not have a locking position. Filip discloses a switch that when pressed it locks in a specific position and closes electrical contacts and when the actuating end of the button is pressed, the switch is released i.e. opens the electrical contacts. One of ordinary skill in the art would replace Yasaku’s switch with Filip’s switch which has a simple mechanism for effecting the locking and locking of the switch. In response to applicant’s argument that the examiner’s conclusion of obviousness is based upon improper hindsight

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reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 8-19 and 20-25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The grounds for rejections stated in paragraph 3 of the Office Action mailed on 10/10/01 paper number 12, are incorporated by reference herein.

Drawings

6. The drawings are objected to under 37 CFR 1.83(a). The grounds for objection stated in paragraph 4 of the Office Action mailed on 10/10/01 paper number 12, are incorporated by reference herein.

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7. The amendment filed 12/21/01 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "Figure 7 shows the projected portion 6b below the recessed portion 10a under the influence of surplus pressure" (second paragraph beginning on line 15 on page 9).

Applicant is required to cancel the new matter in the reply to this Office action.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 20-24, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuyashi Yasaku [Japanese Patent No. 63-5551] in view of Filip (U.S. Patent 4,025,748). The grounds for rejections stated in paragraph 6 of the Office Action mailed on 10/10/01 paper number 12, are incorporated by reference herein.

As to claim 20 [as best understood by the Examiner], refer to claim 20 rejection stated in paragraph 6 of the Office Action mailed on 10/10/01 paper number 12, are incorporated by

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reference herein. Filip further discloses that the electrical contacts are closed when the switch is locked (i.e., the switch is activated only in the lock position) (col.2, lines 45-55).

As to claims 21-24, and 8, refer to claim 21-24 and 8 rejections stated in paragraph 6 of the Office Action mailed on 10/10/01 paper number 12, are incorporated by reference herein.

10. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuyashi Yasaku [Japanese Patent No. 63-5551] in view of Filip (U.S. Patent 4,025,748) as applied to claim 24 above and further in view of Murata (U.S. Patent 4,642,433). The grounds for rejections stated in paragraph 7 of the Office Action mailed on 10/10/01 paper number 12, are incorporated by reference herein.

11. Claims 9-10, 12-16, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuyashi Yasaku [Japanese Patent No. 63-5551] in view of Filip (U.S. Patent 4,025,748) as applied to claim 20 above and further in view of Itsumi et al (U.S. Patent 5,559,504). The grounds for rejections stated in paragraph 8 of the Office Action mailed on 10/10/01 paper number 12, are incorporated by reference herein.

12. Claims 17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuyashi Yasaku [Japanese Patent No. 63-5551] in view of Filip (U.S. Patent 4,025,748) in view of Itsumi et al (U.S. Patent 5,559,504) as applied to claims 16 and 18 above and further in view of Heinz Lubke (DE 29 52 212). The grounds for rejections stated in paragraph 9 of the Office Action mailed on 10/10/01 paper number 12, are incorporated by reference herein.

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13. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuyashi Yasaku [Japanese Patent No. 63-5551] in view of Filip (U.S. Patent 4,025,748) as applied to claim 20 above and further in view of Tsikos (U.S. Patent 4,353,056). The grounds for rejections stated in paragraph 10 of the Office Action mailed on 10/10/01 paper number 12, are incorporated by reference herein.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Samir Ahmed whose telephone number is (703) 305-9870. The examiner can normally be reached on Monday to Friday from 8:00 A.M. to 5:00 P.M.

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The fax number of this Group 2757 is (703) 872-9314. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Au, Amelia can be reached on (703) 308-6604. The fax phone number for this Group is (703) 306-5406.

SA

2/27/02


**SAMIR AHMED
PRIMARY EXAMINER**